

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

CHANEY et al.

Serial No.: 09/437,607

Confirmation No.: 8216

Filed: November 10, 1999

For: RECOVERING METALS FROM SOIL



Art Unit: 1638

Examiner: M. Ibrahim TECH CENTER 1600/2900

Docket No. 108172-00037

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SUBMISSION OF TERMINAL DISCLAIMER

Commissioner for Patents
Washington, D. C. 20231

Date: May 1, 2002

Sir:

Submitted herewith for filing in the above-identified application, are two copies of a Terminal Disclaimer. One copy has been signed by the University of Maryland and the United States of America as Represented by the Secretary of Agriculture, and the other copy has been signed by the University of Sheffield.

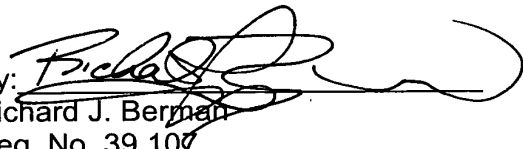
Enclosed is a check in the amount of Fifty Five Dollars (\$55.00) to cover the cost of the fee. In the event that this check is found to be insufficient, or if any additional fees are due with respect to the filing of this paper, please charge Deposit Account Number 01-2300, referencing Docket No. 108172-00037.

05/02/2002 GGEBREGI 00000142 09437607

01 FC:248

55.00 DP

Respectfully submitted,
ARENT FOX KINTNER PLOTKIN & KAHN PLLC

By: 
Richard J. Berman
Reg. No. 39,107

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Telephone (202) 857-6000
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RJB:elp
Enclosure: Terminal Disclaimer; Check No. 339008
112720_1.DOC

CORRECTION OF PATENTS

1490

T. D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 5/19/02TO: EXAMINER IbeaphimAPPL. S.N.: 9/437607

FROM: _____

ART UNIT: 1638SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: 5/19/02

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete, please initial, date and return this memo to me. THANK YOU.

- ☒ The T.D. is PROPER and has been recorded (see ¶ 14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶ 14.24):
- ☐ The recording fee of \$ _____ has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶ 14.26.07).
 - ☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶¶ 14.26 & 14.26.01).
 - ☐ The T.D. lacks the enforceable only during common ownership clause - needed to overcome a double patenting rejection, Rule 321(b) (see ¶ 14.27.01).
 - ☐ The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be a terminal portion of the term of the entire patent to be granted." (MPEP 1490) (see ¶¶ 14.26 & 14.26.02).
 - ☐ The person who signed the T.D.:
 - ☐ is not an attorney "of record" (see ¶¶ 14.29 and 14.29.01).
 - ☐ has failed to state his/her capacity to sign for the business entity (see ¶ 14.28).
 - ☐ is not recognized as an officer of the assignee (see ¶¶ 14.29 & possibly 14.29.02).
 - ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶ 14.30).
 - ☐ The T.D. is not signed (see ¶¶ 14.26 & 14.26.03).
 - ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶ 14.32).
 - ☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶¶ 14.26, 14.26.04 or 14.26.05).
 - ☐ The period disclaimed is incorrect or not specified (see ¶¶ 14.26, 14.27.02 or 14.27.03).
 - ☐ Other: _____
 - ☐ Suggestion to request refund (see ¶ 14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials: _____ Date: _____

RETURN THIS MEMO TO

(Rev. 5/98)



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TECH CENTER 1600/2900

In re application of:

CHANEY et al.

Atty. Docket No. 108172-00037

Serial No.: 09/437,607

Group Art Unit: 1638

Filed: November 10, 1999

Examiner: M. Ibrahim

For: RECOVERING METALS FROM SOIL

TERMINAL DISCLAIMER UNDER 37 CFR 1.321(b)

Commissioner of Patents
Washington, D. C. 20231

Sir:

Petitioners, **UNIVERSITY OF MARYLAND**, College Park, MD, **THE UNITED STATES OF AMERICA AS REPRESENTED BY THE SECRETARY OF AGRICULTURE**, Washington, DC, and **UNIVERSITY OF SHEFFIELD**, Sheffield, United Kingdom, represent that they are jointly the assignee of all right, title and interest in and to the above-identified U. S. Patent Application. . . .
Petitioners are also the joint assignee of all right, title, and interest in and to U. S. Patent No. 5,711,784, issued January 27, 1998.

Petitioner hereby disclaims the terminal part, if any, of any patent granted on application Serial No. 09/437,607, which would extend beyond the expiration date of United States Patent No. 5,711,784, and hereby agrees that any patent so granted on application Serial No. 09/437,607, shall be enforceable only during such period that the legal title to such patent shall be the same as the legal title to United States Patent No. 5,711,784, this agreement to run with any patent

granted on the application, Serial No. 09/437,607, and to be binding on its grantee, its successors, or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term as presently shortened by any terminal disclaimer of U.S. Patent No. 5,711,784 in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321(a), has all claims cancelled by a reexamination certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

Each of the undersigned on behalf of petitioners, **UNIVERSITY OF MARYLAND**, College Park, MD, **THE UNITED STATES OF AMERICA AS REPRESENTED BY THE SECRETARY OF AGRICULTURE**, Washington, DC, and **UNIVERSITY OF SHEFFIELD**, Sheffield, United Kingdom, hereby states and declares: I have the authority to execute this Terminal Disclaimer on behalf of the petitioner under which my signature is affixed.

Each of the undersigned hereby declares: All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United

States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

UNIVERSITY OF MARYLAND

By: James A. Poules
Title: Executive Director
Date: Oct 31, 2001

**THE UNITED STATES OF AMERICA
AS REPRESENTED BY THE
SECRETARY OF AGRICULTURE**

By: Janella S. Grater
Title: Patent Advisor
Date: 10-24-01

UNIVERSITY OF SHEFFIELD

By: _____
Title: _____
Date: _____



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Respectfully submitted,

UNIVERSITY OF MARYLAND

By: _____

Title: _____

Date: _____

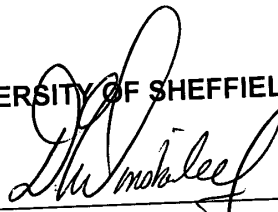
**THE UNITED STATES OF AMERICA
AS REPRESENTED BY THE
SECRETARY OF AGRICULTURE**

By: _____

Title: _____

Date: _____

UNIVERSITY OF SHEFFIELD

By: 

Title: DIRECTOR, TECHNOLOGY TRANSFER OFFICE

Date: 24th April 2002

**Dr. D. J. Winstanley
Director
Technology Transfer Office**